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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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20874	7590	02/15/2011		
MARJAMA MULDOON BLASIAK & SULLIVAN LLP 250 SOUTH CLINTON STREET SUITE 300 SYRACUSE, NY 13202			EXAMINER ELOSHWAY, CHARLES R	
			ART UNIT 3751	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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MARJAMA MULDOON BLASIAK & SULLIVAN LLP
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SYRACUSE NY 13202

In re Application of:

KAWAKAMI, TOSHIAKI

US Pat. No. 6,434,763/issued on August 20, 2002

Serial No.: 09/901,359

Filed: July 9, 2001

Docket: 967_012

Title: SEAT SUPPORTING TABLE FOR A
BARBER OR BEAUTY CHAIR AND
HAIR WASHER WITH THE SEAT
SUPPORTING TABLE

DECISION ON PETITION FOR
ISSUANCE OF CERTIFICATE
OF CORRECTION

This is a decision on the petition filed May 16, 2008 requesting issuance of a certificate of correction to add a foreign reference, DE 3522110 A1 on the cover of the patent. The delay in replying the petition is regretted. The petition is being considered pursuant to 37 CFR 1.181 and no fee is required for the petition.

The petition is **DISMISSED**.

The record shows that:

1. On March 11, 2002, the examiner allowed the application in the first Office action.
2. Prior to the payment of issue fee, on June 11, 2002, the applicant filed an IDS statement request the foreign reference, DE 3522110 A1 be considered and entered of record. In the IDS statement, the applicant included a statement "The present Information Disclosure Statement is being filed (1) no later than three months from the application's filing date or (2) before the mailing date of the first Office Action on the merits (whichever is later), and therefore no certification under 37 C.F.R. § 1.97(e) or fee under 37 C.F.R. § 1.17(p) is required.". The applicant authorized to charge any fee associated with the IDS to the Deposit Account.
3. The Issue Fee was paid on June 24, 2002 and the patent was issued on August 20, 2002.

4. After the patent was issued, the applicant/patentee on October 21, 2002, filed a request for issuance of a Certificate of Correction under 37 CFR §1.322.
5. The examiner on November 26, 2002 and the Certificate of Correction Branch on November 27, 2002 notified the applicant that the IDS filed after the Notice of Allowance has not been considered because the information disclosure statement fails to comply with 37 CFR 1.97(d). In particular, it lacks a statement as specified in 37 CFR 1.97(e) and it lacks the fee set forth in 37 CFR 1.17(p).
6. On October 11, 2007, the patentee filed a second Request for a Certificate of Correction. In the request, the patentee argued that "Under the MPEP 8th, Revision 1, in effect at the time of filing of the May 24, 2002 IDS, a copy of a dated communication from a foreign patent office could be submitted in lieu of the referenced required communication by the applicant under 37 C.F.R. §1.97(e): If an IDS includes a copy of a dated communication from a foreign patent office which clearly shows that the statement is being submitted within 3 months of the date of the communication, the copy will be accepted as the required communication. It will be assumed, in the absence of evidence to the contrary, that the communication was for a counterpart foreign application. In the alternative, a statement can be made if no item of information contained in the IDS was cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the person signing the statement after making reasonable inquiry, neither was it known to any individual having a duty to disclose more than 3 months prior to the filing of the statement. MPEP 609, 8th Rev. 1, August 2001." Patentee also argued that the fee associated with the IDS has been always authorized to be charged to the applicant's Deposit Account and should not be an issue. The Office simply failed to notify the applicant any deficiency of the IDS prior to the issuance of the patent, August 20, 2002. Due to the lack of notice from the Office, the applicant believes the IDS was in compliance with MPEP § 609.
7. On December 11, 2007, the Certificate of Correction Branch erroneously issued the requested Certificate of Correction. Subsequently, on January 15, 2008 and January 16, 2008, the Certificate of Correction Branch notified the applicant such mistakenly issued Certificate of Correction and proposed to withdraw the mistakenly issued Certificate of Correction.
8. On February 12, 2008, the applicant filed a response to the proposed vacation of the mistakenly issued Certificate of Correction. In the response, the applicant argued that the Certificate of Correction of December 11, 2007 was properly issued because the statement requirement under 37 CFR § 1.97 was met. The applicant also argued that the IDS was marked "entered" in the file which distinguishing information that is considered by the Office from information that is not considered. The applicant believed that by entering the IDS which also means the IDS has been considered by the examiner. Therefore, the Office has no basis to vacate the properly issued Certificate of Correction. In support the applicant's position, the applicant also mentioned numerous telephone conversations with different USPTO personnel who did not disagree with the applicant's position that the issued Certificate of Correction of December 11, 2007 should not be vacated. The applicant maintained his belief that a copy of a dated communication from a foreign patent office could be submitted in lieu of the referenced required communication by the applicant under 37 C.F.R. §1.97(e).

9. On February 26, 2008, in the internal memo to the SPE regarding the propriety of the requested Certificate of Correction, the SPE responded in the same manner as previously stated "The IDS was filed 5/24/02 (per the certificate of mailing), which is more than three months after the filing date of the application, and later than the Notice of Allowance mailed March 11, 2002. The IDS was not accompanied by a statement or fee as required by 37 CFR 1.97(d) in these circumstances. Thus, the IDS will not be considered, and the omission of the reference is proper."

10. On April 29, 2008, the Certificate of Correction Branch issued a new Certificate of Correction vacating the mistakenly issued Certificate of Correction of December 11, 2007 because the examiner has not considered the cited foreign reference, DE 3522110 A1.

11. On May 16, 2008, the current petition was filed. Petitioner requests vacation of the latest Certificate of Correction of April 29, 2008 because the Certificate of Correction of December 11, 2007 was proper in view of the properly filed IDS of June 11, 2002.

Issue

The issue in this case is whether or not the IDS filed on June 11, 2002 complied with the requirement of 37 CFR 1.97(d) under the facts of this case. As primarily argued by petitioner, a copy of a dated communication from a foreign patent office could be submitted in lieu of the referenced required communication by the applicant under 37 C.F.R. §1.97(e). If an IDS includes a copy of a dated communication from a foreign patent office which clearly shows that the statement is being submitted within 3 months of the date of the communication, the copy will be accepted as the required communication. It will be assumed, in the absence of evidence to the contrary, that the communication was for a counterpart foreign application.

Discussion and Analysis

A review of the records shows that the examiner allowed the application on March 11, 2002 and three months later the IDS was filed on June 11, 2002 (with certificate of mailing showing the May 24, 2002 date). The issue fee was paid on June 24, 2002 (with certificate of mailing showing June 11, 2002 date). The IDS was submitted after the mailing of the Notice of Allowance of March 11, 2002 and prior to the payment of the Issue fee. During the time period between the filing date of the IDS of June 11, 2002 and issuance of the patent on August 22, 2002, the applicant did not make any inquiry with the examiner regarding whether the IDS was approved or disapproved. Therefore, there is no indication showing the examiner did not act diligently between the period that the IDS was filed and the issue fee was paid.

In the petition, petitioner also argues that the IDS filed on June 11, 2002 was stamped "OK to Enter" which means the examiner must have considered the cited foreign reference, DE 3522110 A1. This assumption is erroneous. The stamp "OK to Enter" on the IDS cover page does not mean that the examiner has considered the cited foreign reference, DE 3522110 A1. In order to show the examiner's consideration, the examiner must put his/her initial on the Form 1449. There is no initialed Form 1449 in the application file for the cited foreign reference, DE 3522110 A1.

In the petition, petitioner seeks to vacate the April 29, 2008 Certificate of Correction and reinstate the Certificate of Correction of December 11, 2007. For this IDS to have been considered, both a statement under 1.97(e) and a fee payment under 1.17(p) were needed. The fee requirement appears to have been met by the fee authorization included with the IDS transmittal letter. With regard to the statement requirement, petitioner argues that inclusion of a dated communication from the foreign patent office satisfies the "statement" requirement. Petitioner also argues that the Office should have accepted the IDS statement filed on June 11, 2002 because 37 CFR §1.97e conditions have been met. The IDS of June 11, 2002 was in satisfaction of 37 CFR §1.97e requirement at the time it was filed because at the time the IDS was filed, submittal of a dated foreign Office action could be submitted in satisfaction of the 37 CFR §1.79(e) statement requirement. Applicant actually refers to the original 8th edition of the MPEP dated August 2001, section 609 (page 600-128). The version of MPEP in effect (dated August 2001) at the time of the submission of this IDS does NOT indicate that to be the case. This line of arguments is not persuasive. The requirement of the 37 CFR § 1.97(e) statement is a requirement of the rule, 37 § CFR 1.97(d). Where an IDS is submitted after a notice of allowance but before the payment of the issue fee, applicant is required to submit a 1.97(e) statement. The portion of the MPEP that petitioner referenced does not state that the submission of a dated copy of the foreign office communication will be considered as satisfying the 1.97(e) statement. The language in that paragraph of the MPEP states that "the copy will be accepted as the required communication." Note that it does not state that the copy will be accepted as the required 1.97(e) statement. Since applicant failed to submit the 1.97(e) statement as required by the rule, the examiner was correct in refusing to consider the cited prior art references DE 3522110 A1 in the IDS filed on June 11, 2002.

Under the circumstances, the examiner could not have considered the cited foreign reference, DE 3522110 A1 in the IDS of June 11, 2002. Subsequently, the vacation of the mistakenly issued Certificate of Correction of December 11, 2007 was correct. However, the vacation of the mistakenly issued Certificate of Correct of December 11, 2007 is regretted.

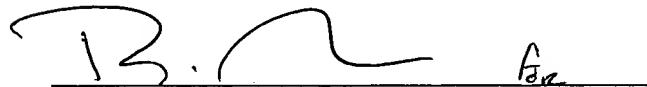
Conclusion

Pursuant to MPEP 1481¹, the requested relief for issuance of a Certificate of Correction to list the cited foreign reference, DE 3522110 A1 on the cover page of the patent cannot be granted because the mistake for failure to cite the foreign reference is not a clerical or typographical nature, or of minor character. A review of the file history in this application does not show that there is any mistake made by the Office in denying consideration of the cited foreign reference. The examiner's refusal to consider the IDS filed on June 11, 2002 is in compliance with proper examining practice as set forth in M.P.E.P. § 609. Therefore, the requested relief for vacating the Certificate of Correction of April 29, 2008 will not be granted. The examiner's refusal to consider the IDS filed on June 11, 2002 is proper.

¹ A relevant portion of MPEP 1481 states: [R-3] Certificates of Correction - Applicant's Mistake 35 U.S.C. 255. Certificate of correction of applicant's mistake. Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Director may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination

Petitioner may file a request for reconsideration of this decision, without fee. However, such request must be filed within two months of the date of this decision. Should petitioner have any further questions, he is invited to contact TC 3700 SPRE Henry Yuen at 571-272-4856.

Accordingly, the petition is dismissed.



Karen M. Young, Director
Technology Center 3700